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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,609	02/04/2000	David L. Hecht	07447.0016-0	9053

7590

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT PAPER NUMBER

2876

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/498,609

Applicant(s)

HECHT ET AL.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Acknowledgment is made of the receipt of the amendment filed on 1/2/03. Claims 1-32 are currently pending.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 9-12, 16-19, 25-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nukui et al. (US 5,945,661) (hereinafter referred to as 'Nukui') in view of Wang (US 5,304,787) (hereinafter referred to as 'Wang '787') and Chandler (US 5,241,166).

Nukui teaches a data symbol reading device 1 for reading a data symbol 38 featuring data

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embedded therein, having an indication section 18 which notifies the device 1 user of a positioning condition of the device 1 relative to a symbol reading area 36 of the data symbol 38 on a surface 37 (col. 11, lines 18-33). The device 1 also features an operation switch 14, two light sources 41, and a charge coupled device 43 (col. 5, lines 29-31).

Nukui lacks the teaching of embedded data including a location of the coded embedded data on the substrate.

Wang '787 teaches a stored image area 40 which encases a two-dimensional bar code. Stored image data representing the image area 40 is sampled along or between parallel scan lines. The image data is then analyzed to determine the bounds and orientation of the bar code (col. 5, line 38- col. 6, line 16).

One of ordinary skill in the art would have readily recognized that it would have been beneficial to the invention of Nukui to determine the position of the code for use in enabling the further processing of the image. Therefore, it would have been obvious, at the time the invention was made, to modify the teaching of Nukui with the aforementioned teaching of Wang '787.

Nukui/Wang '787 lack the teaching of embedded data including an orientation of the substrate.

Chandler teaches a code which is embedded with unique patterns that, when read, determines the orientation of the label on which the code lies (col. 11, line 67-col. 12-line 21).

One of ordinary skill in the art would have readily recognized that it would have been beneficial to the invention of Nukui/Wang '787 to determine the orientation of the code for use in enabling the further processing of the image. Therefore, it would have been obvious, at the

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time the invention was made, to modify the teachings of Nukui/Wang '787 with the aforementioned teaching of Chandler.

4. Claims 4-8, 13-15, 20-24, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nukui/Wang '787/Chandler as applied to claim 1 above, and further in view of Wang et al. (US 5,513,264) (hereinafter referred to as 'Wang '264'). The teachings of Nukui/Wang '787/Chandler have been discussed above.

Nukui/Wang '787/Chandler lack the teaching of the viewing area comprising a display for displaying an image based on the coded embedded data.

Wang '264 teaches a decoding system 30 having a display unit 34 arranged to display a visual representation of a dataform (col. 5, lines 4-13). Following decoding, a displayed visual representation of the decoded data may be provided (fig. 8 and col. 9, lines 13-15).

One of ordinary skill in the art would have readily recognized that a display would have been beneficial on the scanner for allowing the user to readily view the code and decoded data as a means to ensure that one has properly carried out the scanning process. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Nukui/Wang '787/Chandler with the display as taught by Wang '264.

#### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

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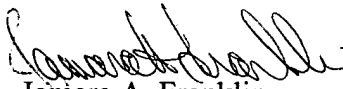
With respect to the argument that the references of record do not teach embedded data including an orientation of the substrate, the examiner has provided a new grounds of rejection to read upon the claimed limitations.

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
Jamara A. Franklin  
Examiner  
Art Unit 2876

JAF  
March 12, 2003

  
Daine I. Lee  
Primary Examiner  
GAU 2876